



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,587	09/15/2003	Kuo-Jung Hsu	TOP 322	8059
23995 7590 07/01/2008				
RABIN & Berdo, PC				
1101 14TH STREET, NW				
SUITE 500				
WASHINGTON, DC 20005				
EXAMINER				
SHERMAN, STEPHEN G				
ART UNIT		PAPER NUMBER		
2629				
MAIL DATE		DELIVERY MODE		
07/01/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/661,587

Applicant(s)

HSU, KUO-JUNG

Examiner

STEPHEN G. SHERMAN

Art Unit

2629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4-15 and 17-24 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1, 4-15 and 17-24 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 15 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

1. This office action is in response to the amendment filed 21 April 2008. Claims 1, 4-15 and 17-24 are pending.

Response to Arguments

2. Applicant's arguments filed 21 April 2008 have been fully considered but they are not persuasive.

On page 10 of the response the applicant argues that "nothing in Kawa et al. can be construed to disclose that the area where the touchpad is mounted is any different than the rest of the housing", whereas, "on the other hand, the housing of the present invention is configured so as to have an identifying portion that identifies where the touchpad is mounted, for example by being thinner or being concave with respect to other parts of the housing." The examiner respectfully disagrees. Claim 1, for example, does not say anything about identifying where the touchpad is mounted or that it is thinner or concave. The claim merely changed the wording, a receiving portion, to state an identifying portion, which changes nothing in the meaning of the claim. And although Kawa et al. does not explicitly use the words of having an "identifying portion", clearly there is a portion of the housing in which the touch pad is disposed, as explained in the rejection below, and therefore this portion is an "identifying portion" as claimed since the claims are broad and do not specify what is meant by an "identifying portion". Further,

the meaning of identifying portion was amended into the specification, which is a new matter objection to the specification since there is no support for the limitation to be added to the specification. The fact that the priority documents support the addition to the limitation does not change the fact that the limitation is not supported by the originally filed specification, and furthermore, also indicates that the originally filed specification is not the same as the priority documents and therefore calls to question whether the foreign priority date should be granted.

Specification

3. The amendment filed 21 April 2008 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The paragraph on line 2, lines 10 through 18, where it was added "The main portion includes a housing, formed with a receiving portion or identifying portion" and "The touch pad is disposed in the receiving portion or identifying portion, which identifies the position for mounting the touch pad".

Applicant is required to cancel the new matter in the reply to this Office Action.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1, 4-5, 9-11, 14, 19, 21 and 23-24 are provisionally rejected on the ground of nonstatutory double patenting over claims 17, 20-26 and 28-30 of copending Application No. 11/515,761. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: The present claims are merely broader versions of the copending claims.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

The following is an example for comparing claim 1 of this application and claim 17 of copending Application No. 11/515,761.

Claim 1 of the present application	Claim 17 of copending Application No. 11/515,761
A notebook computer with a hidden touch pad, comprising:	A notebook computer, comprising:
a <u>main portion</u> including a <u>housing portion</u> , wherein the <u>housing portion has an internal surface having an identifying portion</u> ;	a <u>main portion</u> including a <u>housing portion</u> , the housing portion further including a first surface and a second surface, the first surface opposed to the <u>second surface</u> ;
	a <u>receiving portion on the second surface</u> , wherein the receiving portion further has a concave portion ;
a <u>display</u> connected to the main portion in a rotatable manner;	a <u>display</u> connected to the main portion in a rotatable manner; and
and a <u>touch pad</u> disposed onto the identifying portion; wherein the housing portion prevents the touch pad from being exposed to an atmosphere outside of the housing portion.	a <u>touch pad</u> disposed in the housing portion, attached to the concave portion , facing the second surface and overlaid by the housing portion.

As can be seen above, besides wording (for example claim 1 of the present application states "identifying portion" and claim 17 of the copending application states

"receiving portion", where the applicant admits that the receiving and the identifying portions are the same thing), the only major difference between the present claim 1 and the copending claim 17 is that claim 17 states of a "concave portion" where as claim 1 of the present application fails to recite this feature, thus making is broader than the copending claim. Further, the present claim 1 recites the feature "wherein the housing portion prevents the touch pad from being exposed to an atmosphere outside of the housing portion", whereas the copending claim 17 fails to recite this feature, however, since the copending claim recites that the housing overlays the housing (the recitation "a touch pad disposed in the housing portion, attached to the concave portion, facing the second surface and overlaid by the housing portion"), it is an inherent feature that it "prevents the touch pad from being exposed to an atmosphere outside of the housing portion". Therefore, the present claims are merely broader versions of the copending claims and are not patentably distinct.

Claim 4 is similarly rejected over claim 17 of copending Application No. 11/515,761.

Claim 5 is similarly rejected over claim 22 of copending Application No. 11/515,761.

Claim 9 is similarly rejected over claim 30 of copending Application No. 11/515,761.

Claim 10 is similarly rejected over claim 17 of copending Application No. 11/515,761.

Claim 11 is similarly rejected over claim 22 of copending Application No. 11/515,761.

Claim 14 is similarly rejected over claim 30 of copending Application No. 11/515,761.

Claim 19 is similarly rejected over claim 20 of copending Application No. 11/515,761.

Claim 21 is similarly rejected over claim 20 of copending Application No. 11/515,761.

Claim 23 is similarly rejected over claim 17 of copending Application No. 11/515,761.

Claim 24 is similarly rejected over claim 17 of copending Application No. 11/515,761.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2629

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 1, 7-10, 12-14, 19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawa et al. (JP 2002-297309).

Regarding claim 1, Kawa et al. disclose a notebook computer with a hidden touch pad (Drawing 1), comprising:

a main portion including a housing portion (Drawing 1 shows body 2 which is a housing portion.),

wherein the housing portion has an internal surface having a receiving portion (Drawing 3b and paragraph [0023] explain that the body 2 has the surface shown as item 54 in the drawing, and that this internal side has a portion for receiving the touch pad.),

a display connected to the main portion in a rotatable manner (Drawing 1 shows display section 3); and

a touch pad disposed onto the receiving portion (Drawing 3b shows that touchpad portion 53 is received by the body 2.);

wherein the housing portion prevents the touch pad from being exposed to an atmosphere outside of the housing portion (Paragraph [0024]).

Kawa et al. fail to explicitly teach wherein the internal surface has an identifying portion, however, it would have been obvious to "one of ordinary skill" in the art at the time the invention was made to make the receiving portion of Kawa et al. identify where the touch pad is to be attached such that the touch pad will be attached to the proper location in each notebook computer during manufacture.

Regarding claim 7, Kawa et al. disclose the notebook computer as claimed in claim 1.

Kawa et al. fail to teach of the notebook computer wherein the thickness of the receiving portion is about 0.5-0.8mm.

However, since it is not shown in the specification how this specific range proves to be beneficial to the overall device, it would have been obvious to "one of ordinary skill" in the art at the time the invention was made to make the thickness of the receiving portion between .5-.8 mm since a notebook computer is portable and it is important to have the overall size of the notebook computer be relatively small meaning that all the components located inside of the computer would also need to be small.

Regarding claim 8, Kawa et al. disclose the notebook computer as claimed in claim 1.

Kawa et al. fail to teach of the notebook computer wherein the difference between the thickness of the receiving portion and that of a portion, adjacent to the receiving portion, of the housing is about 0.7-1.0 mm.

However, since it is not shown in the specification how this specific range proves to be beneficial to the overall device, it would have been obvious to "one of ordinary skill" in the art at the time the invention was made to make the difference between the thickness of the receiving portion and that of a portion, adjacent to the receiving portion, of the housing to be about 0.7-1.0 mm because it is important for the housing to keep a relatively small size but still be thicker than other components in the computer such that the internal components are protected properly.

Regarding claim 9, Kawa et al. disclose the notebook computer as claimed in claim 1.

Kawa et al. fail to teach of the notebook computer wherein a ratio between the thickness of the receiving portion and the thickness a portion, adjacent to the receiving portion, of the housing is about 1/3-1/2.

However, since it is not shown in the specification how this specific range proves to be beneficial to the overall device, it would have been obvious to "one of ordinary skill" in the art at the time the invention was made to make the ratio between the thickness of the receiving portion and that of a portion, adjacent to the receiving portion, of the housing to be about 1/3-1/2 mm because it is important for the housing to keep a

relatively small size but still be thicker than other components in the computer such that the internal components are protected properly.

Regarding claim 10, please refer to the rejection of claim 1, and furthermore the examiner understands that if the notebook of Kawa et al. can be made then there is method for manufacturing it that can form the housing and adhere the touchpad.

Regarding claim 12, this claim is rejected under the same rationale as claim 7.

Regarding claim 13, this claim is rejected under the same rationale as claim 8.

Regarding claim 14, this claim is rejected under the same rationale as claim 9.

Regarding claim 19, Kawa et al. disclose the notebook computer as claimed in claim 1, wherein the housing portion further includes an external surface (Drawing 3b and paragraph [0023] explain that the body 2 has the surface shown as item 54 in the drawing.).

Regarding claim 21, this claim is rejected under the same rationale as claim 19.

9. Claims 4 and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawa et al. (JP 2002-297309) in view of Novak (US 6,933,929).

Regarding claim 4, Kawa et al. disclose the notebook computer as claimed in claim 1.

Kawa et al. fail to explicitly teach wherein the identifying portion is a concave portion.

Novak discloses a notebook computer comprising a housing portion (Figure 4A shows housing portion 412 and 432.) comprising an internal surface having an identifying portion, wherein the identifying portion is a concave portion (Figure 4A shows that within the housing portion there is a concave portion where the touchpad 414 is disposed.).

Therefore, it would have been obvious to "one of ordinary skill" in the art at the time the invention was made to use the teachings of Novak in the notebook computer taught by Kawa et al. such that there would be a concave portion where the touchpad is to be disposed in order to more securely attach the touchpad with the housing portion while also allowing for easier detection of touch in a pressure-sensitive touchpad (Paragraph [0025] of Kawa et al.).

Regarding claim 23, this claim is rejected under the same rationale as claims 1 and 4.

Regarding claim 24, this claim is rejected under the same rationale as claims 10 and 4.

10. Claims 17-18, 20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawa et al. (JP 2002-297309) in view of Garner (US 6,501,462).

Regarding claim 20, Kawa et al. disclose the notebook computer as claimed in claim 19.

Kawa et al. fail to teach that the housing further includes a flange on the external surface, and the flange surrounds a surface corresponding to the identifying portion.

Garner discloses of a notebook computer wherein the housing further includes a flange on the external surface, and the flange surrounds the surface correspond to an identifying portion (Figure 1, item 39 and column 4, lines 5-12. The examiner interprets that item 39 is a flange which surround the touch pad portion item 35.).

Therefore it would have been obvious to "one of ordinary skill" in the art at the time the invention was made to use the flange taught by Garner with the notebook computer taught by Kawa et al. in order to provide improved tactile feedback such that the touchpad can be found without looking for it with the eye.

Regarding claim 17, Kawa et al. disclose the notebook computer as claimed in claim 20.

Garner discloses of a notebook computer wherein the flange on the external surface is an identifier (Figure 1, item 39 and column 4, lines 5-12, where the flange identifies where the touchpad is and therefore is an "identifier".).

Regarding claim 22, this claim is rejected under the same rationale as claim 21.

Regarding claim 18, this claim is rejected under the same rationale as claim 17.

11. Claims 5-6, 11 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawa et al. (JP 2002-297309) in view of Keely, JR. et al. (US 2002/0063694).

Regarding claim 5, Kawa et al. disclose the notebook computer as claimed in claim 1.

Kawa et al. fail to teach of the notebook computer further comprising: an adhesive member adhering the touch pad to the receiving portion.

Keely, JR. et al. disclose of a notebook computer further comprising: an adhesive member adhering a touch pad to the outer surface opening (Paragraph [0041]).

Therefore it would have been obvious to "one of ordinary skill" in the art at the time the invention was made to adhere the touch pad using adhesive as taught by Keely, JR. et al. to the outer edges of the receiving portion of the notebook computer taught by Kawa et al. in order to provide the desired stiffness, producing permanent alignment, shock control, the spread of impact forces along the edges, and liquid seal, with minimum cost, weight, and number of parts.

Regarding claim 6, Kawa et al. and Keely, JR. et al. disclose the notebook computer as claimed in claim 5.

Keely, JR. et al. also discloses wherein the touch pad is closely adjacent to the outer surface opening via the adhesive member, thereby eliminating any gap between the outer surface opening and the touch pad (Paragraph [0041]. The examiner interprets that when anything is sealed with an adhesive such that liquids are prevented from entering that the gap between the two items is eliminated.).

Regarding claim 11, this claim is rejected under the same rationale as claims 5 and 6.

Regarding claim 15, Kawa et al. and Keely, JR. et al. disclose the method as claimed in claim 10.

Kawa et al. and Keely, JR. et al. fail to teach of the method wherein the housing is formed by injection molding.

However, it would have been obvious to "one of ordinary skill" in the art at the time the invention was made to form the housing using injection molding since it is well known that the injection molding process has high production rates, allows design flexibility, has relatively low labor, and has minimum scrap losses.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **STEPHEN G. SHERMAN** whose telephone number is (571)272-2941. The examiner can normally be reached on **M-F, 8:00 a.m. - 4:30 p.m.**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amr Awad can be reached on (571) 272-7764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2629

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Stephen G Sherman/
Examiner, Art Unit 2629

25 June 2008
/Bipin Shalwala/
Supervisory Patent Examiner, Art Unit 2629